

REMARKS

In response to the office action of August 17, 2009, Applicants have amended claims 4, 11 and 12, and added new claim 35, which when considered with the following remarks is deemed to place the present application in condition for allowance. Favorable consideration of all pending claims is respectfully requested.

In the August 17th office action, claim 11, and claims 12-14, dependent thereon, have been rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The position of the Examiner is that claim 11 is indefinite in the recitation of "preferably a prolamin promoter" because it is unclear whether and under what conditions a prolamin promoter would be preferred.

In response to the rejection, claim 4 has been amended to recite in relevant part: "a construct comprising a promoter which functions in a plant cell operably linked to a nucleic acid molecule encoding a GRUBX protein." Support for the amendment may be found throughout the specification, e.g., page 24, lines 2-7 of WO 2005/059147. Claim 11 has been amended to recite a seed-preferred promoter. Newly added claim 35, dependent on claim 11, is directed to the seed-preferred promoter, prolamin. Withdrawal of the rejection of claims 11 and 12-14 under 35 U.S.C. §112, second paragraph, is therefore respectfully requested.

Claims 4, 5 and 9 have been rejected under 35 U.S.C. §102(a) as allegedly anticipated by INZE et al. "I" (WO 03/085115, published October 16, 2003). Claims 4, 5, and 9 have also been rejected under 35 U.S.C. §102(e) as allegedly anticipated by INZE et al. "II" (U.S. Patent Application Publication US 2005/0221290, published October 6, 2005 and filed April 8, 2003).

INZE et al. I and II are relied upon for allegedly teaching a method comprising introducing and expressing or overexpressing in a plant a nucleic acid molecule isolated from *Nicotiana tabacum* that comprises the nucleotide sequence of SEQ ID NO:1 and that encodes a protein consisting of the amino acids sequence set forth in SEQ ID NO:2. SEQ ID NO:61 of both INZE et al. I and II, as well as INZE et al. I, page 12, lines

4-19 and page 13, lines 23-26, have been cited for this teaching. The Examiner has also cited INZE et al. II, paragraphs [0060], [0063], [0067], [0068], and [0069] for this teaching.

In response to the rejection, claim 4 has been amended to recite: "A method for improving plant growth characteristics, said method comprising introducing and expressing in a plant a construct comprising a promoter which functions in a plant cell operably linked to an isolated nucleic acid molecule encoding a GRUBX protein, said GRUBX protein consisting of the amino acid sequence set forth in SEQ ID NO:2."

It is respectfully submitted that neither INZE et al. I nor INZE et al. II, teaches the subject matter recited in claim 4 and claims dependent thereon, claims 5 and 9.

On page 11 of the office action, the Examiner maintains that the nucleic acid molecule taught by INZE et al. I and II encodes a protein consisting of the amino acid sequence set forth in SEQ ID NO:2, *as evidenced by the start and stop codons of SEQ ID NO:61.*

In response, Applicants respectfully submit that although a nucleotide sequence comprising Applicants' SEQ ID NO:1 is set forth in SEQ ID NO: 61 of both INZE et al. I and INZE et al. II, there is no indication in either INZE et al. reference, as to what reading frame in SEQ ID NO:61 is relevant to the presently claimed GRUBX protein. In SEQ ID NO:61 of both INZE et al. I and INZE et al. II, there are several potential ATG start codons and several potential TAA, TAG or TGA stop codons.

Neither INZE et al. reference provides a protein sequence consisting of the amino acid sequence of Applicants' SEQ ID NO:2. Therefore, there is no way for one skilled in the art having either INZE et al. I or INZE et al. II in hand, to have known how to make a construct comprising a promoter which functions in a plant cell operably linked to an isolated nucleic acid molecule encoding a GRUBX protein, said protein consisting of SEQ ID NO:2. The relevant start and stop codons of SEQ ID NO:61 which correlate to the translated protein having the amino acid sequence of Applicants' SEQ ID NO:2 are first provided by Applicants' disclosure in Applicants' SEQ ID NO:1, and not the cited references. The subject matter of claims 4, 5, and 9 is therefore distinguished from

INZE et al. I and INZE et al. II, and withdrawal of the rejection of claims 4, 5 and 9 under 35 U.S.C. § 102(a) and (e) is therefore warranted.

In view of the foregoing remarks and amendments to the claims, it is firmly believed that the present application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted


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